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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,473	08/01/2003	Marc Brian Wisnudel	132742 (108.21)	5449

7590 12/10/2004

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EXAMINER

KEEHAN, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/633,473

Applicant(s)

WISNUDEL ET AL.

Examiner

Christopher M. Keehan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-25 and 29-34 is/are rejected.
- 7) ☒ Claim(s) 26-28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/3/03, 10/3/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, drawn to an adhesive composition, classified in class 524, subclass 379.
- II. Claims 16-34, drawn to a limited play storage medium, classified in class 428, subclass 64.4.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as product and process of use.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in a materially different process of using that product, such as in a laminate.

During a telephone conversation with Christopher Bernard on November 23, 2004, a provisional election was made with traverse to prosecute the invention of Group II, claims 16-34. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

Claims 17-21 and 26-28 are objected to for the following reason. Claims 17 and 18 contain references to structures VI and VII, which are present in the specification. However, the structures are not present in the claims. Applicant should amend claims 17 and 18 to contain the actual structures of VI and VII. Appropriate correction is required.

Double Patenting

Claims 16-25 and 29-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/417991. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons as set forth below.

The instant application claims a substrate and at least a layer thereon, wherein the layer comprises at least a reactive material and a photo-bleaching retarder. The claims of 10/417991 claim a reactive material and at least one polyhydroxy compound. Although 10/417991 does not claim a photo-bleaching retarder, applicant defines a photo-bleaching retarder in the specification as a polyhydroxy compound. Further,

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10/417991 does not specifically claim a substrate. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the composition of 10/417991 to a substrate because the composition would have to be on some surface, such as the surface of a limited play optical disc as set forth in 10/417991 (claim 18).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 16-25 and 29-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 8, 10-14, and 16-21 of copending Application No. 10/657632. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons as set forth below.

The instant application claims a substrate and at least a layer thereon, wherein the layer comprises at least a reactive material and a photo-bleaching retarder. The claims of 10/657632 claim a reactive material and at least one polyhydroxy compound. Although 10/657632 does not claim a photo-bleaching retarder, applicant defines a photo-bleaching retarder in the specification as a polyhydroxy compound. Further, 10/657632 does not specifically claim a substrate. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the composition of 10/657632 to a substrate because the composition would

have to be on some surface, such as the surface of a limited play optical medium as suggested by 10/657632 (claim 18).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 16-18, 20, 22-24, and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Lawandy et al. (6,531,262 B1). Regarding claims 16-18, 20, and 22-24, Lawandy et al. disclose a limited play data storage medium comprising at least one substrate, at least one reactive layer comprising at least one carrier material, at least one reactive material disposed within the carrier material, and a photo-bleaching retarder material, more specifically polyhydroxystyrene within the carrier material (col.17, lines 27-32).

Regarding claim 33, Lawandy et al. disclose a substantially colorless substrate (col.10, line 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lawandy et al. (6,531,262 B1) in view of Bakos et al. (6,537,635 B1). Lawandy et al., as applied above, are as set forth and incorporated herein. Lawandy et al. disclose a substrate of an optically readable disk (col.6, lines30-32). Lawandy et al. do not appear to specifically disclose a polymeric substrate as claimed. Bakos et al. disclose a substrate for a limited optical storage medium comprising an optical disk comprising polycarbonate and other materials (col.4, lines 1-5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the substrate of Lawandy et al. to be composed of polycarbonate, among other materials, because Bakos et al. teach that a typical optical disk comprises polycarbonate.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lawandy et al. (6,531,262 B1). Lawandy et al., as applied above, are as set forth and incorporated herein. Lawandy et al. do not appear to specifically disclose a substrate as claimed. However, as the substrate of Lawandy et al. is used for the same purpose as that of applicant's, it would have been obvious to one of ordinary skill in the art at the

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time the invention was made for the substrate of Lawandy et al. to be substantially red, because an at least similar use would appear to result in an at least similar type of substrate.

Allowable Subject Matter

Claims 26-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and the objection to these claims as addressed above is also cleared up. The prior art of record does not appear to teach or disclose the instantly claimed combination of photo-bleaching retarders in the claimed composition.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is (571) 272-1087. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Keehan

November 29, 2004

Christopher Keehan
Art Unit 1712
Ceehan